

### REMARKS

Applicant thanks the Examiner for conducting the interview of September 26, 2006. Applicant has amended claims 3, 8, 28 and 34. No new matter is entered thereby. Claims 3 and 8 have been amended, in accordance with the suggestions discussed during the telephonic interview of September 26, 2006, to more clearly define the scope of the claimed invention. Support for the amendments to claim 3 can be found in the text of claims 3 and 8 as originally filed. Support for the amendments to claim 8 can be found, e.g., in previously presented claim 9 and claim 34. Claims 4-7, 9, 10, 27, 29-33, and 35-40 are previously presented. Claims 1-2, and 11-26 are cancelled. Claims 3-10 and 27-40 are presented for examination.

### 35 U.S.C. § 112

Claims 3-7, 10, and 27-40 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 3, this claim has been rejected for failing to provide proper antecedent basis for the claim term "the location," which appeared in lines 4-5 of that claim. Claims 4-7, 10, and 27 have been rejected as being dependent from rejected claim 3. Applicant has amended claim 3 to recite, in pertinent part, "a location." Applicant respectfully requests reconsideration and withdrawal of these rejections in view of the amendments to claim 3.

Regarding claim 28, this claim has been rejected for failing to provide proper antecedent basis for the claim language "the open text document," which appeared in line 3 of that claim. Claim 29-40 have been rejected as being dependent from rejected claim 28. Applicant has amended claim 28 to recite, in pertinent part, "an open text document." Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 28-40 in view of the amendments to claim 28.

### 35 U.S.C. §101

Claims 3, 8, and 28 have been rejected under 35 U.S.C. §101 as not being drawn to statutory subject matter. Applicant requests reconsideration of these rejections in light of the above amendments and the following remarks.

### Claim 3

The Examiner rejected claim 3 under 35 U.S.C. §101 as allegedly not being drawn to statutory subject matter. Without addressing the merits of this rejection, and in order to advance the prosecution of the patent application, Applicant has amended claim 3 to more fully recite the tangible nature of the embodiments therein described and to more particularly define the subject matter being claimed. As amended, claim 3 recites, in pertinent part: "A text editing system comprising a software program disposed in an electronic format on a first computing device, said software program including ..."

As is made clear in both the MPEP and case law, a computer-readable medium storing instructions to operate a computer is statutory subject matter. According to the MPEP §2106(IV)(B)(1), "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component." Applicant submits that the electronic document and active messaging modules of the claim 3 broadly constitute a data structure, as that term is defined in the MPEP. Specifically, "[t]he definition of 'data structure' is a 'physical or logical relationship among data elements, designed to support specific data manipulation functions.'" MPEP §2106(IV)(B)(1). Accordingly, the phrase "electronic document generation module configured to..." in line 3, claim 3, and "active messaging module configured to ..." in line 7, claim 3, describe functional descriptive material. Finally, the MPEP makes clear that "when functional descriptive material is recorded in some computer-readable medium [e.g., 'disposed in an electronic format on a first computing device'] it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of descriptive material to be realized." *Id.* See also, *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir 1994).

Accordingly, Applicant submits that claim 3 is drawn to statutory subject matter and respectfully requests reconsideration and withdrawal of this rejection.

#### Claim 8

The Examiner has rejected claim 8 under 35 U.S.C. §101 as allegedly not being drawn to statutory subject matter. Applicant respectfully disagrees with the Examiner's position, and submit that the method defined by claim 8 is clearly drawn to patentable subject matter under 35 U.S.C. §101.

Referring to MPEP §2106 IV(B)(1)(b), a claim directed toward a computer-related process is statutory provided it either: (i) results in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan; or (ii) is limited to a practical application in the technological arts. "If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to practical use, is sufficient." As discussed above, Applicant has amended claim 8 to recite "displaying the response to the user . . .," i.e., a physical transformation that occurs outside the computer.

Furthermore, Applicant submits that claim 8 is limited a practical application in the technological arts. As noted, for example, in the Specification at page 2, lines 10-27, claim 8 provides a computer-implemented document editing method that allows users to save time by allowing the creator of an electronic document to integrate the process of collecting information with the process of incorporating that information in the development of that document; and reduces errors in document creation by, e.g., "reducing the number of steps required to complete the task in which human error would produce a copying-related error, ..." The computer-implemented document editing method of claim 8 also provides for a collaborative data flow while maintaining full control of the document by its "owner" (author[creator]) so that nothing in the document is altered outside the control of the author and ... provides access to unknown information desired by a user in the context of creating a document in a logical, efficient, unified manner.

Accordingly, claim 8 is directed to statutory subject matter, and, therefore, Applicant respectfully requests that this rejection be withdrawn.

#### Claim 28

The Examiner has rejected claim 28 under 35 U.S.C. §101 as allegedly not being drawn to statutory subject matter. The Examiner apparently suggests that the subject matter of claim 28 "is an 'abstract idea,' and, therefore, it is not a 'practical application' ... because it does not produce a "concrete and tangible result." (Office Action of June 1, 2006, page 3). The Examiner appears to rely principally on *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368, 47 USPQ.2d 1596 (Fed. Cir. 1998) in support of this rejection.

*State Street Bank* held "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations in a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result' – a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373. Applicant submits that the *State Street Bank* case requires only that there be a practical application for a claimed invention, which may be, but is not required to be, shown by the claimed invention having a useful, concrete and tangible result. Moreover, Applicant submits that *State Street Bank* also does not require that such a result, where it supports utility of the claimed invention, be explicitly recited in the claim itself. Indeed, the result identified for the claim in the *State Street Bank* case is not recited in the claim itself.

Turning now to an analysis of claim 28, there is a practical application that supports the claim meeting the requirements of Section 101, as enunciated in the *State Street Bank* case. Specifically, the practical application is expressly cited in the preamble of the claim as "... editing a text document," and is inherent in the steps recited in the claim. More specifically, the invention isn't manipulating a variable, but, rather, it is editing a text document. Furthermore, the practical application is also described in detail, with various examples, in Applicant's specification. For example, Applicant's specification explains that the method may be useful in

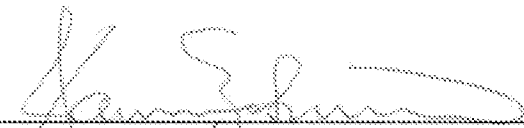
"... allowing the creator of a document to integrate the process of collecting needed information with the process of incorporating that information [into a text document]." (Specification, at page 5, lines 22-24.) It is also useful in reducing errors by, e.g., "reducing the number of steps required to complete the task [i.e., of editing a text document] in which human error would produce a copy error." (Specification, at page 5, lines 25-27.) As another example, the claimed configuration can also be useful in maintaining data flow through the owner/author of the edited text document so that nothing in the document is altered outside the control of the author. (Specification, at page 5, lines 30-31.)

Accordingly, Applicant submits that claim 28 is directed to statutory subject matter, and respectfully requests that this rejection be withdrawn.

The fee in the amount of \$60 for the extension of time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket number 13605-004001.

Respectfully submitted,

Date: September 27, 2006

  
James W. Babineau  
Reg. No. 42,276

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906